

REMARKS/ARGUMENTS

The Applicants originally submitted Claims 1-20 in the application. In a previous response, the Applicants amended Claims 1 and 15. In view of the Final Rejection of October 17, 2007, and the Advisory Action of January 30, 2008, the Applicants have amended Claims 1, 6-7, 15 and 18 in the present preliminary amendment. Support for the amendment can be found, for example, in paragraphs 19-20, 24-25, 27 and 29 of the original specification. Claims 1-20 are currently pending in the application.

I. Rejection of Claims 1-7 and 15-20 under 35 U.S.C. §101

The Examiner has rejected Claims 1-7 and 15-20 under 35 U.S.C. §101 for being directed to non-statutory subject matter. In response, the Applicants have amended independent Claims 1 and 15 to render this rejection moot. Support for these amendments can be found, for example, in paragraph 25 of the original specification which states:

In the illustrated embodiment of the present invention, the graph generator 110, the graph converter 120 and the description generator 130 are embodied in sequences of instructions executable in a general purpose computing system. Of course, the graph generator 110, the graph converter 120 and the description generator 130 could be implemented in hardware, firmware or any suitable combination of hardware, firmware or software.

Thus, the original filed specification does provide support for the systems of Claims 1 and 15 to be a plurality of instruction (sequences of instructions), stored on a computer-readable medium, including instructions that when executed by a processor cause the processor to implement the systems (executable in a general purpose computing system). Accordingly, the Applicants

respectfully request the Examiner to withdraw the §101 rejection and allow issuance of Claims 1 and 15 and Claims dependent thereon.

II. Rejection of Claims 1-2, 4-9 and 11-14 under 35 U.S.C. §103

Previously, the Examiner rejected Claims 1-2, 4-9 and 11-14 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,937,190 to Gregory, *et al.* in view of U.S. Patent No. 5,568,644 to Nelson, *et al.*, and further in view of Practical C Programming, 3rd Edition, O'Reilly, August 1997 to Oualline. The Applicants respectfully disagree in view of amended independent Claim 1 and the below arguments.

The Examiner recognized that neither Gregory, Nelson, nor the combination thereof, teach or suggest the description generator as claimed. To cure this deficiency, the Examiner cited Oualline. (*See* Final Rejection, pages 4-5.) The Applicants fail to find, however, where Oualline teaches or suggests a description generator as presently recited in amended Claim 1. More specifically, the Applicants fail to find where Oualline teaches or suggests a description generator that generates a static tree description to form a hierarchical register consolidation structure to provide a logical representation of: (1) microprocessor-accessible registers, (2) node interrelationships, (3) summary bits and (4) masks of external devices identified in an HDL file. On the contrary, as applied by the Examiner, Oualline discloses data structures for a chess program. (*See* section 17.10.) Thus, even assuming *arguendo* that Oualline discloses a static tree description, Oualline does not appear to teach or suggest such a static tree description as recited in amended

Claim 1. As such, the applied combination of Gregory, Nelson and Oualline does not provide a *prima facie* case of obviousness of amended independent Claim 1 and Claims dependent thereon.

Regarding Claim 8, the examiner relies on the combination of Gregory and Nelson to disclose "parsing a High-level Design Language (HDL) file to generate an intermediate graph containing definitions of microprocessor-accessible registers, node interrelationships and summary bits and masks associated with alarm registers." (*See* Final Rejection, pages 5-7.) The Applicants fail to see how this applied combination renders obvious parsing a HDL file as recited in Claim 8. First, assuming *arguendo* that Nelson discloses such an intermediate graph as recited in Claim 8, a person of ordinary skill in the art having common sense at the time of the invention would not have reasonably looked to Gregory for another way of providing an intermediate graph that is already provided by Nelson. This is especially true since Gregory provides no teaching or suggestion of an intermediate graph as claimed, but instead relates to analyzing and debugging digital circuits constructed from HDL source text. (*See* column 1, lines 16-19.) Neither Gregory nor Nelson even relate to automatically generating a hierarchical register consolidation structure as recited in Claim 8.

Additionally, the applied combination of Gregory and Nelson fails to enable parsing a HDL file to generate an intermediate graph containing definitions of microprocessor-accessible registers, node interrelationships and summary bits and masks associated with alarm registers. A "disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation." (*See* MPEP 2121.01 citing *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003).)

More specifically addressing an obviousness rejection, *In re Kumar* states that “in order to render an invention unpatentable for obviousness, the prior art must enable a person of ordinary skill to make and use the invention.” (See *In Re Kumar*, No. 04-1074, (Fed. Cir. 2005), citing *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed. Cir.1989).)

The Examiner asserts that Gregory does provide an enabling discloser for parsing a HDL file to generate an intermediate graph and that Nelson discloses an intermediate graph as recited in Claim 8. (See Final Rejection, page 19.) Even assuming these assertions to be true, Gregory, Nelson or even the combination thereof fail to disclose how a person of ordinary skill in the art could parse a HDL file to generate the intermediate graph of Nelson. Thus, the cited combination does not provide a *prima facie* case of obviousness of Claim 8 and Claims dependent thereon. If the Examiner disagrees, the Applicants respectfully request the Examiner to indicate how the cited combination would generate an intermediate graph containing definitions of: (1) microprocessor-accessible registers, (2) node interrelationships and (3) summary bits and (4) masks associated with alarm registers by parsing a HDL file.

Accordingly, based on the above amendment of Claim 1 and the arguments regarding Claim 8, the Applicants respectfully request the Examiner to withdraw the §103(a) rejection with respect to Claims 1-2, 4-9 and 11-14 and allow issuance thereof.

Regarding dependent Claims 6-7, the Applicant also do not find where the cited combinations render these amended claims obvious.

III. Rejection of Claims 3, 10 and 15-20 under 35 U.S.C. §103

The Examiner has rejected Claims 3, 10 and 15-20 under 35 U.S.C. §103(a) as being unpatentable over Gregory and Nelson in view of Oualline, and further in view of Perl & LWP, O'Reilly, June 2002 to Burke. The Applicants respectfully disagree in view of amended Claims 1 and 15 and the above arguments regarding Claim 8.

As discussed above the cited combination of Gregory, Nelson and Oualline does not provide a *prima facie* case of obviousness for independent Claims 1 and 8. The cited combination of Gregory, Nelson and Oualline, therefore, also does not provide a *prima facie* case of obviousness of amended independent Claim 15. Burke has not been cited to cure the above noted deficiencies of the cited combination but to teach an HTML traversable tree representation based on a mathematical tree. (See Final Rejection, page 12.) Thus, the cited combination of Burke with Gregory, Nelson and Oualline also fails to provide a *prima facie* case of obviousness of independent Claims 1, 8 and 15 and Claims dependent thereon. Accordingly, the Applicants respectfully request the Examiner to withdraw the §103(a) rejection with respect to Claims 3, 10 and 15-20 and allow issuance thereof.


IV. Conclusion

In view of the foregoing amendment and remarks, the Applicants now see all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-20.

The Applicants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

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